

REMARKS

Claims 1-18 are pending.

Claims 1-18 are rejected.

Claim 15 is currently amended.

Rejection of Claims under 35 U.S.C. § 101

Claims 15-18 stand rejected. Claim 15 has been amended to incorporate the suggested language presented in the Office Action. Applicant recognizes that the Examiner has discretion in entering an amendment after final rejection, but believes that the present amendment overcomes Examiner's rejection under 35 U.S.C. § 101 by incorporating language suggested by the Examiner in paragraph 5 of the most recent Office Action. This amendment is not believed to require additional search or raise new issues. Entry is respectfully requested.

Rejection of Claims under 35 U.S.C. § 103

Claims 1-3, 5-8, 10, and 12-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kopsaftis, U.S. Patent No. 5,659,801 ("Kopsaftis"), in view of Torrey et al., U.S. Patent Appl. No. 2003/0084240 ("Torrey") and Jantz, U.S. Patent No. 5,867,736 ("Jantz"). Applicants respectfully traverse this rejection.

Initially the Applicants would like to point out that while Jantz was recited in introduction of the rejection, it appears that the Office Action does not rely upon Jantz to disclose any limitation of the present application. Applicants will respond to the Office Action accordingly. If however, the rejection intended to rely upon Jantz, then

Applicants respectfully request another Office Action be sent out detailing the portions of which Jantz is relied upon. Further, it is noted that dependent claims such as 4 and 9 would also require the inclusion of Jantz to teach all of limitations of these dependent claims if indeed Jantz were required for the rejection of independent claims 1 and 6.

As stated in the MPEP § 706.02 (j), to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See **MPEP § 2143 - § 2143.03** for decisions pertinent to each of these criteria. Emphasis added.

In re claims 1 and 6, the Office Action states Kopsaftis teaches a method including “assigning a first LUN to a first device...said first device receiving one or more commands...said first device obtaining a LUN address from each of said one or more commands...” (*Office Action, paragraph 10*).

The Office Action recognizes that Kopsaftis fails to explicitly teach assigning a second LUN to a memory and states that Torrey teaches assigning a first LUN to a first device and assigning a second LUN to a memory (see Office Action paragraph 10).

The Office action relies upon the combination of Kopsaftis and Torrey to teach that in response to said LUN address obtained from each of said one or more commands being equal to said LUN, updating said microcode in said memory using said LUN address assigned to said second LUN by processing each of said one or more commands.

The cited portion of Kopsaftis discloses when “the initiator command is detected, no transfer of data is performed...[i]nstead the disk drive enters a state ready to receive new microcode....the resident processor 106, now under the control of the resident microcode in non-volatile memory 108 clears a buffer in the resident RAM 110 of sufficient size to hold the new microcode when an initiator command is detected” (*Kopsaftis column 8, line 63 through column 9, line 2*).

In contrast, the claims recite “*in response to said LUN address obtained from each of said one or more commands being equal to said second LUN, updating said microcode in said memory using said LUN address assigned to said second LUN by processing each of said one or more commands.*”

The Office Action recognizes that Kopsaftis fails to teach assigning a second LUN to a memory (*Office Action paragraph 10*). Therefore, Kopsaftis also fails to disclose that that in response to said LUN address obtained from each of said one or more commands being equal to said second LUN updating said microcode in said memory using said LUN address assigned to said second LUN by processing each of said one or more commands.

The cited portions of Torrey teach the use of “logical unit numbering to address different portions of the library” (Torrey, paragraph [0015]) and that if a “request is directed to only a portion or specific elements of the library, the library controller uses the SCSI LUN assigned to the storage elements, media and I/O elements involved to carry out the request...” (Torrey, paragraph [0020]).

The cited portions of Torrey fails to teach that *a second LUN is assigned to a memory*, and further that in response to said *LUN address* obtained from each of said one or more commands being *equal to said second LUN*, updating said microcode in said memory using said LUN address assigned to said second *LUN by processing each of said one or more commands*.

The cited portions of Kopsaftis and Torrey, either alone or in combination, do not disclose, assigning a *second LUN to a memory*. Further the cited portions of Kopsaftis and Torrey, either alone or in combination, do not disclose, that the LUN address from the command received by the first device is equal to the second LUN, and in response updating said microcode. Rather, Kopsaftis teaches that the microcode update is accomplished by an initiator command being detected.

Further, the cited portions of Kopsaftis and Torrey, either alone or in combination, do not teach that the microcode is upgraded in said memory *using said LUN address assigned to said second LUN* by processing each of said one more commands.

Accordingly, Applicants submit that all of the claim limitations of independent claims 1 and 6 have not been shown by Kopsaftis and Torrey, alone or in combination as required by § 706.02 (j) of the MPEP. It follows then that a *prima facie* case of

obviousness has not been met with respect to claims 1 and 6. Accordingly, Applicants respectfully submit that claims 1 and 6 are allowable for at least this reason over Kopsaftis and Torrey, either alone or in combination.

Claims 2-3, and 5 depend from independent claim 1 and are allowable for at least this reason. Claims 7-8, 10, and 12-14 depend from independent claim 6, and are allowable for at least this reason.

Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kopsaftis and Torrey in further view of Shirasawa et al., U.S. Patent Appl. No. 2002/0166027 (“Shirasawa”).

In re claim 4, Applicants submit above that the combination of Kopsaftis and Torrey fail to teach or suggest all of Applicants claim limitations in, at least, independent claim 1. Accordingly, as claim 4 depends from claim 1, Applicant respectfully submit that all of the claim limitations of claim 4 have not been shown by Kopsaftis and Torrey in view of Shirasawa, alone or in combination. Accordingly, Applicants respectfully submit that claim 4 is allowable for at least this reason over Kopsaftis, Torrey and Shirasawa, either alone or in combination.

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kopsaftis and Torrey in further view of Pellegrino et al., U.S. Patent Appl. No. 2004/0225775 (“Pellegrino”).

In re claim 9, Applicants submit above that the combination of Kopsaftis and Torrey fail to teach or suggest all of Applicants claim limitations in, at least, independent

claim 6. Accordingly, as claim 9 depends from claim 6, Applicant respectfully submit that all of the claim limitations of claim 9 have not been shown by Kopsaftis and Torrey in view of Pellegrino, alone or in combination. Accordingly, Applicants respectfully submit that claim 9 is allowable for at least this reason over Kopsaftis, Torrey and Pellegrino, either alone or in combination.

Claim 11 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kopsaftis and Torrey in further view of Abbott et al., U.S. Patent No. 6,205,093 ("Abbott").

In re claim 11, Applicants submit above that the combination of Kopsaftis and Torrey fail to teach or suggest all of Applicants claim limitations in, at least, independent claim 6. Accordingly, as claim 11 depends from claim 6, Applicant respectfully submit that all of the claim limitations of claim 11 have not been shown by Kopsaftis and Torrey in view of Abbott, alone or in combination. Accordingly, Applicants respectfully submit that claim 11 is allowable for at least this reason over Kopsaftis, Torrey and Abbott, either alone or in combination.

Claims 15-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kopsaftis and Torrey in further view of Burton et al., U.S. Patent No. 6,393,535 ("Burton").

In re claim 15, the Office Action states Kopsaftis teaches a method including "assigning a first LUN to a first device...said first device receiving one or more commands...said first device obtaining a LUN address from each of said one or more commands..." (*Office Action, paragraph 10*).

The Office Action recognizes that Kopsaftis fails to explicitly teach assigning a second LUN to a memory and states that Torrey teaches assigning a first LUN to a first device and assigning a second LUN to a memory (see Office Action paragraph 10).

The Office action relies upon the combination of Kopsaftis and Torrey to teach that in response to said LUN address obtained from each of said one or more commands being equal to said LUN, updating said microcode in said memory using said LUN address assigned to said second LUN by processing each of said one or more commands.

The cited portion of Kopsaftis discloses when “the initiator command is detected, no transfer of data is performed...[i]nstead the disk drive enters a state ready to receive new microcode....the resident processor 106, now under the control of the resident microcode in non-volatile memory 108 clears a buffer in the resident RAM 110 of sufficient size to hold the new microcode when an initiator command is detected” (*Kopsaftis column 8, line 63 through column 9, line 2*).

In contrast, the claims recite “*in response to said LUN address obtained from each of said one or more commands being equal to said second LUN, updating said microcode in said memory using said LUN address assigned to said second LUN by processing each of said one or more commands.*”

The Office Action recognizes that Kopsaftis fails to teach assigning a second LUN to a memory (*Office Action paragraph 10*). Therefore, Kopsaftis also fails to disclose that that in response to said LUN address obtained from each of said one or more commands being equal to said second LUN updating said microcode in said

memory using said LUN address assigned to said second LUN *by processing each of said one or more commands*.

The cited portions of Torrey teach the use of “logical unit numbering to address different portions of the library” (Torrey, paragraph [0015]) and that if a “request is directed to only a portion or specific elements of the library, the library controller uses the SCSI LUN assigned to the storage elements, media and I/O elements involved to carry out the request...” (Torrey, paragraph [0020]).

The cited portions of Torrey fails to teach that *a second LUN is assigned to a memory*, and further that in response to said LUN address obtained from each of said one or more commands being *equal to said second LUN*, updating said microcode in said memory using said LUN address assigned to said second LUN *by processing each of said one or more commands*.

The Office Action states Burton “teaches an article of manufacture comprising a data storage medium tangibly embodying a program of machine-readable instruction executed by a processing apparatus to perform method steps” (*Office Action paragraph 27*).

The cited portion of Burton does not disclose *a memory assigned to a second LUN*. Further, Burton does not disclose that *in response to said LUN address obtained from each of said one or more commands being equal to said second LUN*, updating said microcode in said memory using said LUN address assigned to said second LUN *by processing each of said one or more commands*.

The cited portions of Kopsaftis, Torrey, and Burton either alone or in combination, do not disclose, assigning a *second LUN to a memory*. Further, the cited portions of Kopsaftis, Torrey, and Burton, either alone or in combination, do not disclose, that the LUN address from the command received by the first device is equal to the second LUN, and in response updating said microcode. Rather, Kopsaftis teaches that the microcode update is accomplished by an initiator command being detected.

Further, the cited portions of Kopsaftis, Torrey, and Burton, either alone or in combination, do not teach that the microcode is upgraded in said memory *using said LUN address assigned to said second LUN* by processing each of said one more commands.

Accordingly, Applicants submit that all of the claim limitations of independent claim 15 have not been shown by Kopsaftis, Torrey, and Burton, alone or in combination as required by § 706.02 (j) of the MPEP. It follows then that a *prima facie* case of obviousness has not been met with respect to claim 15. Accordingly, Applicants respectfully submit that claim 15 is allowable for at least this reason over Kopsaftis, Torrey, and Burton either alone or in combination.

Claims 16-17 depend from independent claim 15 and are allowable for at least this reason.

Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kopsaftis, Torrey, and Burton, in further view of Shirasawa.


In re claim 18, Applicants submit above that the combination of Kopsaftis, Torrey and Burton fail to teach or suggest all of Applicants claim limitations in, at least,

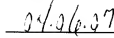
independent claim 15. Accordingly, as claim 18 depends from claim 15, Applicant respectfully submit that all of the claim limitations of claim 18 have not been shown by Kopsaftis, Torrey, Burton and Shirasawa, alone or in combination as required by §706.02 (j) of the MPEP. It follows then that a *prima facie* case of obviousness has not been met with respect to claim 18. Accordingly, Applicants respectfully submit that claim 18 is allowable for at least this reason over Kopsaftis, Torrey, Burton and Shirasawa, either alone or in combination.

CONCLUSION

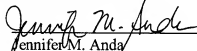
In view of the remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at the numbers provided below.

I hereby certify that this correspondence is being submitted via EFS herewith to:
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Halka Gordon


Date of Signature

Respectfully submitted,


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